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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,171	02/04/2002	Sally Mossman	210121.721	8073

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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/068,171	Applicant(s) MOSSMAN ET AL.	
	Examiner Shengjun Wang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91,94,96-100,102,105-114 and 117-126 is/are pending in the application.
- 4a) Of the above claim(s) 96-98,100,108-110,112,113,120 and 122-126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91,94,99,102,105-107,111,114,117-119,121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks, and the 132 declaration submitted August 24, 2006 is acknowledged.

Double Patenting Rejections

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 91, 94, 99, 101, 102, 105, 111, 114, 117, 121 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-25, 29-30 of copending Application No. 10/177,115, (now 7,030,094). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein are generic to those claims in '115. '115 claims a method of enhancing the immune response with QS 21 and, RC-529, a compound with the scope of the compounds herein.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 91, 92, 94, 99, 101, 102, 105, 111, 114, 117, 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and in further view of applicants' own admission.
3. Johnson et al. teach that aminoalkyl glucosamine phosphates, including the particular elected AGP herein, are known as adjuvant, and immunoeffectors. Johnson further teaches that the adjuvants composition may be in various forms including oil-in-water or water-in-oil emulsions, aqueous composition, liposome, etc; vaccine composition comprising the AGP and antigen. Johnson et al. also teach a method of using the AGP for enhancing the immune response of an animal. See, particularly, the abstract, columns 2-5, example 20 in column 42, and the claims.
4. Johnson et al do not teach expressly the employment of a combination of AGP and Quil A for enhancing the immune response.
5. However, Kensil et al. teaches that Quil A, including QS 21, is known to be useful as immune adjuvant, which is useful for stimulating immune response, particularly co-administered with antigen. The adjuvant may be administered individually or admixed with other adjuvants to achieve the enhancements of the immune response to antigen, including those of tuberculosis. See, particularly, the abstract, column 6, line 54 to column 7, lines 40, and the claims.

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Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make a composition comprising the two adjuvants herein, i.e., Quil A and the particular AGP herein, and optionally further comprising antigen, such as those for tuberculosis.

A person of ordinary skill in the art would have been motivated to composition comprising the two adjuvants herein, i.e., Quil A and the particular AGP herein, and optionally further comprising antigen, such as those for tuberculosis because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus , the claimed invention which is a combination of two known adjuvants sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. As to the particularly amount of each active ingredients herein, note, the optimization of a result effective parameter, e.g., amounts of the active ingredients in a pharmaceutical composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. With respect to the particular antigen herein, note applicants acknowledged that such antigen was known in the art. See the example 1 herein at page 74. Using a known antigen properly is within the skill of artisan.

6. Claims 106, 107, 118, and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and in further view of applicants' own admission as set forth above, and in further view of De Vrier et al.

7. Johnson et al. and Kensil et al. as a whole do not teach expressly the employment of phospholipid in the immunogenic composition employed herein.

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8. However, De Vries et al. disclosed that for immunogenic composition with antigens, surfactants, such as phospholipids, are known to be useful, particularly with saponin. See, particularly, the abstract, col. 3, lines line 9-62, and the claims.

9.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to incorporate surfactants, such as phospholipids in the aqueous immunogenic composition.

A person of ordinary skill in the art would have been motivated to incorporate surfactants, such as phospholipids in the aqueous immunogenic composition because surfactants, such as phospholipids, are known to be useful in such composition for stabilizing the antigen containing composition.

10. Claims 91, 92, 94-95, 99, 101, 102, 105, 111, 114, 117, 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and in further view of applicants' own admission, for reasons discussed above, and in further view of Johnson (US 2001/0053363, IDS) or Mossman et al. (WO 02/03961, IDS).

11. Johnson and Mossman et al. provide further motivation to combine the two adjuvants, AGP and Quil A. Particularly, Mossman et al. teach that AGP and Quil A are useful together and disclose a composition comprising both AGP and Quil A, See, particularly, claims 32 and 42. The AGP disclosed by Mossman including those herein employed see the figures. Johnson also discloses that saponin and AGP adjuvants are useful together and may produce synergistic effect. See, particularly example 7 at pages 28-29. Therefore, one of ordinary skill in the art, would

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have been further motivated to combine the two adjuvants as herein claimed, since it have been shown that two adjuvants are useful together as have been expected, and may produce synergistic effect.

12. Claims 106, 107, 118, and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and in further view of applicants' own admission as set forth above, and in further view of De Vrier et al, for reasons set forth above, and in further view of Johnson (US 2001/0053363, IDS) or Mossman et al. (WO 02/03961, IDS).

13. Johnson and Mossman et al. provide further motivation to combine the two adjuvants, AGP and Quil A. Particularly, Mossman et al. teach that AGP and Quil A are useful together and disclose a composition comprising both AGP and Quil A, See, particularly, claims 32 and 42. The AGP disclosed by Mossman including those herein employed see the figures. Johnson also discloses that saponin and AGP adjuvants are useful together and may produce synergistic effect. See, particularly example 7 at pages 28-29. Therefore, one of ordinary skill in the art, would have been further motivated to combine the two adjuvants as herein claimed, since it have been shown that two adjuvants are useful together as have been expected, and may produce synergistic effect.

Response to the Arguments

Applicants' amendemnts, remarks, and the 132 declaration submitted August 24, 2006 have been fully considered, but are not persuasive.

The declaration under 37 CFR 1.132 filed August 24, 2006 is insufficient to overcome the rejection of claim 91, 92, 94-95, 99, 101, 102, 105, 111, 114, 117, 121 based upon Johnson et

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al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and Johnson et al. (US 6,113,918, IDS) in view of Kensil et al. (US 5,057,540), and in further view of applicants' own admission, and in further view of Johnson (US 2001/0053363, IDS) or Mossman et al. as set forth in the last Office action because: the evidence of unobvious presented in the declaration are not clear and convincing. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e). The evidence is not clear and convincing for a prima facie case of synergistic effects of the particular combination. Particularly, it is unclear as to why the same DPV+QS-21 has three different values. Further, The evidence is not clear and convincing for a prima facie case of a significant and unexpected results, particularly, considering the teaching of Johnson (US 2001/0053363, IDS) or Mossman et al., which suggest a synergistic effect of that AGP and Quil A.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHENGJUN WANG
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Art Unit 1617